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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,763	04/26/2005	Matthias Muller	NY-DNAG-300-US	3415
24972	7590	05/03/2006	EXAMINER	
FULBRIGHT & JAWORSKI, LLP 666 FIFTH AVE NEW YORK, NY 10103-3198			ADDISU, SARA	
			ART UNIT	PAPER NUMBER
			3722	
DATE MAILED: 05/03/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/524,763	<b>Applicant(s)</b> MULLER ET AL.	
	<b>Examiner</b> Sara Addisu	<b>Art Unit</b> 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 11-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 February 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/15/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. Figures 3 and 4 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).  
Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

2. The abstract of the disclosure is objected to because it is in claim format and contains legal phraseology, e.g. "comprises".. Correction is required. See MPEP § 608.01(b).
3. The disclosure is objected to because of the following informalities: page 2, line 2 refers to "claim 1".

Appropriate correction is required.

***Double Patenting***

4. Applicant is advised that should claim 17 be found allowable, claims (23 & 24), claims (35 & 36) and claims (53 & 54) will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof (note: although claims 24, 36 and 54 depend from claim 18, claim 18 is identical to claim 17, also see 112 rejection below for claim 18). When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 18 and 67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 18 recited the same limitation as claim 17 (from which it depends from). It is not clear how the limitation of claim 18, further limits claim 17.

For the purpose of this Office Action, Examiner assumes that it is the same limitation.

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- Claim 67 recites, "a cutting tool comprising a cutting plate according to claim 11". It is not clear how the limitation of claim 67, further limits claim 11. For the purpose of this Office Action, Examiner assumes that it is the same limitation.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

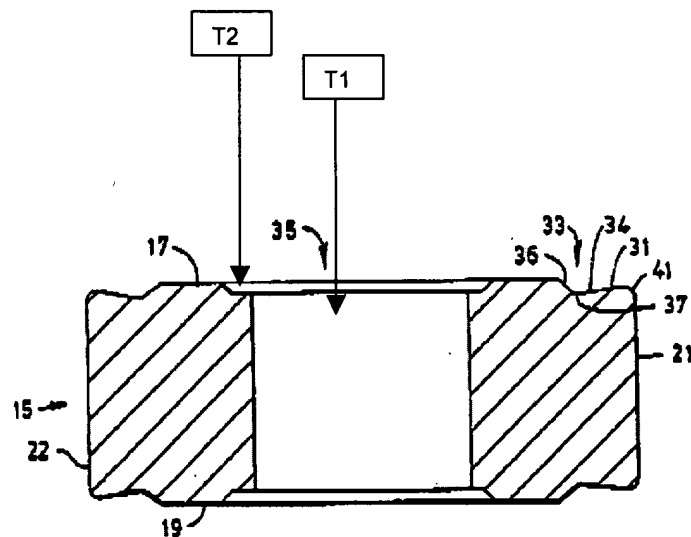
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 11, 12, 17, 18, 23, 24, 29, 30, 35, 36, 41, 42, 47, 48, 53, 54, 59, 60, 65 and 67, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Katbi et al. (USP 4,963,061).

Regarding claim 11, KATBI ET AL. teaches a cutting plate (15) comprising an upper side (17), a first clamping trough (T1: through hole part of opening 35), a cutting edge, a second clamping portion (T2: see figure below) arranged coaxially with respect to the first clamping trough ('061, figure 2). The first clamping trough (T1) is deeper than the second clamping portion (T2). KATBI ET AL. also teaches in figure 2, both troughs (T1, T2) being arranged such that they are deeper than upper surface (17). Regarding claim 12, KATBI ET AL. teaches in figure 1, both clamping troughs being round.

Regarding claims 17, 23 and 24, as shown in the figure below, T2 forms an annular surface that is parallel to the upper side (17). Regarding claims 29, 30, 35, 36, 41, 42, 47, 48, 53, 54, 59, 60 and 65, KATBI ET AL. teaches an indexable ceramic insert.



**FIG. 2**

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 11-67, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Andras (US. Pub. No. 2003/0086766).

Regarding claim 11, ANDRAS teaches a cutting plate (10) comprising an upper side (12), a first clamping trough (16), a cutting edge (32,34), a second clamping trough (18) arranged coaxially with respect to the first clamping trough (16) ('766, figures 1 and 1A-1F) (note, this type of trough feature corresponds to figure 12 of the instant application. Also see Specification, page 5, lines 8-14). The first clamping trough (16) is deeper than the second clamping trough (18). ANDRAS also teaches in figures 2A and 2B, both troughs (16, 18) being arranged such that they are deeper than upper surface (12) ('766, page 2, paragraph 21, lines 1-4). Regarding claim 12, ANDRAS teaches in figure 1, both clamping troughs (16, 18) being round. Regarding claims 13-16, ANDRAS teaches the first clamping trough (16) forming a surface/an elevation (42) that is parallel to the cutting plate upper side (12) or is formed so that it is trough-shaped ('766, figure 2B). Regarding claims 17-28, ANDRAS teaches in figures 1, 1A, 2A and 2B, the second clamping trough (18) forming an annular surface (36) that is parallel to the cutting plate upper face (12). Regarding claims 29-46, Examiner takes Official Notice that it is old and well known to use ceramic material to make cutting inserts (as evidenced by Katbi et al., USP 4,963,061, see above 102 rejection). Regarding claims 47-65, ANDRAS teaches an indexable cutting insert. Regarding claim 66, the claimed phrase "the first and second clamping troughs have been introduced during production by a pressing process", is being treated as a product by process limitation. As set forth in MPEP 2113, product by process claims are NOT limited to the manipulations of the recited steps,

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only to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 U.S.C. 102/103 rejection may be made and the burden is shifted to applicant to show an unobvious difference. See MPEP 2113. Thus, ANDRAS's teaching of the insert having troughs would be the same or similar as that claimed (i.e. troughs being introduced during production by pressing process).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 13-16, 19-22, 25-28, 31-34, 37-40, 43-46, 49-52, 55-58, 61-64 and 66, are rejected under 35 U.S.C. 103(a) as being unpatentable over Katbi et al. (USP 4,963,061), in view of Sjoö (WO 99/30860).

KATBI ET AL. teaches a cutting plate (15) comprising an upper side (17), a first and second clamping trough (T1, T2), as set forth in the above rejection. Furthermore, regarding claims 19-22 and 25-28, as shown in the figure above, T2 forms an annular surface that is parallel to the upper side (17). Regarding claims 31-34, 37-40, 43-46, 49-52, 55-58, 61-64 KATBI ET AL. teaches an indexable ceramic insert. Regarding claim



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66, KATBI ET AL. teaches the ceramic insert being formed by hot pressing or cold pressing ('061, Col. 3, lines 29-32). Furthermore, the claimed phrase "the first and second clamping troughs have been introduced during production by a pressing process", is being treated as a product by process limitation. As set forth in MPEP 2113, product by process claims are NOT limited to the manipulations of the recited steps, only to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 U.S.C. 102/103 rejection may be made and the burden is shifted to applicant to show an unobvious difference. See MPEP 2113. Thus, KATBI ET AL.'s teaching of the insert (having troughs) being produced by hot or cold pressing would be the same or similar as that claimed (i.e. troughs being introduced during production by pressing process).

However, KATBI ET AL. fails to teach the first clamping trough forming a surface that is parallel to the cutting plate upper side or is formed so that it is trough-shaped.

SJOO teaches a ceramic cutting insert having an upper face (12) having a recess (5) with first clamping trough/cavity with an elevation (18) and a second clamping trough (21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify KATBI ET AL. such that the first clamping trough (T1) is trough shaped with an elevation, as taught by SJOO for the purpose of accommodating a clamp instead of bolt. Furthermore, KATBI ET AL. teaches that

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typically ceramic inserts are mounted to a cutting tool holder with a clamp so a central opening is not necessary ('061, Col. 2, lines 62-64).

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Addisu at (571) 272-6082. The examiner can normally be reached on 8:30 am - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on (571) 272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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4/30/06

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